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EXAMINER

DAO, MINH D

ART UNIT

PAPER NUMBER

2682

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4

Please find below and/or attached an Office communication concerning this application or proceeding.

GM

Office Action Summary

Application No.

09/745,493

Applicant(s)

SHAH, NITIN J.

Examiner

MINH D DAO

Art Unit

2682

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE ____ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12/22/2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-7, 9-20 and 23 is/are rejected.
- 7) ☒ Claim(s) 11, 21 and 22 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Art Unit: 2682

Detailed Actions

Claim Objections

1. The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

Misnumbered claims 12-23 have been renumbered 11-22.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 8 is rejected under U.S.C 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 8, the claim depends on itself. It is unclear if this claim should depend on claim 7 since the claim recites the limitation as set forth in

Art Unit: 2682

claim 7. In the following art rejection, the examiner rejection claim 8 with his best understanding.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-3, 9, 10, 17-18, 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Claxton US Patent 6,434,371** and further in view of **Tyneski et al. US Patent 5,584,054**.

Regarding claim 1, **Claxton** discloses an integrated mobile device (Col. 2, Lines 11-13) that provides local functionality and communication functionality (Col. 2, Lines 13-17), comprising:

a power supply (Col. 7, Lines 3-7);

a computing unit, coupled to the power supply (Col. 3, Lines 51-61; See Fig. 7, Item 102);

a radio communication unit (Col. 4, Lines 4-19; See Fig. 6, Item 102); and

Art Unit: 2682

a switch (Col. 4, Lines 35-40), coupled to power supply and to the computing unit (Col. 4, Lines 40-48), to selectively couple the radio communication unit to the power supply (Col. 4, Lines 35-49), such that the switch provides first and second modes of operation (Col. 4, Lines 35-49), wherein the first mode of operation enables the computing unit and the radio communication unit (Col. 2, Lines 11-14). However, **Claxton** fails to teach that the second mode of operation disables the radio communication unit and enables the computing unit. **Tyneski et al.**, on the other hand in his invention, teaches that the second mode of operation of the invention disables the radio communication unit and enables the computing unit (Col. 1, Lines 64-67; Col. 2, Lines 1-7).

It would therefore have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of **Claxton** and **Tyneski et al.** so that one can avoid being cumbersome due to having to carry separate devices for a wireless telephone and personal organizer.

Regarding claim 2, **Claxton** also teaches that the radio communication device provides cellular communication between the wireless communication device (Col. 2, Lines 11-17) and an external entity.

Regarding claim 3, **Claxton** fails to teach the limitations in claim 3, however, **Tyneski et al.** teaches that the computing unit comprises a data storage area to store information and a processor to retrieve the information (Col. 2, Lines 8-27).

Art Unit: 2682

Regarding claim 9, the claim is the method claim of the apparatus of claim 1.

Therefore, the claim is interpreted and rejected for the same reason as set forth in claim 1.

Regarding claim 10, **Claxton** and **Tyneski et al.** fail to teach that the method of claim 9, further comprising providing a third mode of operation in which neither the wireless communication functionality nor the local functionality of the device is enabled. However, it is inherently known in the art that if the user does not wish to use the device he/she could simply switch off the device therefore all functionalities are disabled.

Regarding claim 17, the claim is interpreted and rejected for the same reason as set forth in claim 1.

Regarding claim 18, **Claxton** further teaches that the selection means comprises a switching means to switch between the first and second modes of operation (Col. 2, lines 7-17).

Regarding claim 22, **Claxton** also teaches that the device further comprising an indication means for indicating whether the apparatus is operating in the first or

Art Unit: 2682

the second mode of operation (Fig.3, Item 310; Col. 4, Lines 64-67; Col. 5, Lines 1-5).

4. Claims 4-6, 11-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Claxton US Patent 6,434,371, Tyneski et al. US Patent 5,584,054.** and further in view of **Uchikura US Patent 5,337,346.**

Regarding claim 4, **Claxton** and **Tyneski et al.** fail to teach that the information includes random access information. However, **Uchikura** in his invention discloses that the information includes random access information (Col. 5, Lines 22-24).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to combine the teachings of **Claxton, Tyneski et al.** and **Uchikura** to include the random access, read-only information, and the multimedia information in the invention to provide a portable telephone apparatus including an electronic notebook.

Regarding claim 5, **Claxton** and **Tyneski et al.** fail to teach that the information includes read-only information. However, **Uchikura** in his invention discloses that the information includes read-only information (Col. 5, Lines 19-22).

Art Unit: 2682

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to combine the teachings of **Claxton, Tyneski et al.** and **Uchikura** to include the random access, read-only information, and the multimedia information in the invention to provide a portable telephone apparatus including an electronic notebook.

Regarding claim 6, **Claxton** and **Tyneski et al.** fail to teach that the information includes multimedia information. However, **Uchikura** in his invention discloses that the information includes multimedia information (Col. 5, Lines 51-66).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to combine the teachings of **Claxton, Tyneski et al.** and **Uchikura** to include the random access, read-only information, and the multimedia information in the invention to provide a portable telephone apparatus including an electronic notebook.

Regarding claim 11, **Claxton** further teaches that switching between the first and second modes of operation comprises:

in the first mode of operation, providing power (Col.4, Lines 60-67; Col.5, lines 1-2) to a computing unit and a radio communication unit of the integrated portable computing-communication device, wherein the computing unit provides the local functionality and the radio communication unit provides the communication

Art Unit: 2682

functionality. However, both **Claxton** and **Tyneski et al.** fail to teach that in the second mode of operation, providing power to the computing unit, but not to the communication unit. **Uchikura**, on the other hand discloses a procedure to provide power to the computing unit, but not to the communication unit (Col. 6, lines 50-58; See Figs. 1,3).

It would therefore have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of **Claxton** and **Tyneski et al.** and **Uchikura** to have modified the invention to provide power to the computing unit but not to the communication unit within the communication-computing device therefore one would have access to the computing unit without being interrupted by the communication unit.

Regarding claim 12, the claim is interpreted and rejected for the same reason as set forth in claim 11.

5. Claims 7-8, 13-16, 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Claxton US Patent 6,434,371**, **Tyneski et al. US Patent 5,584,054**. and further in view of **Ditzik US Patent 5,983,073**.

Regarding claim 7, **Claxton** and **Tyneski et al.** fail to teach that the wireless communication device of claim 1, wherein the computing device, when the radio

Art Unit: 2682

communication unit is enabled, provides data communication functionality between the device and an external entity. **Ditzik** on the other hand teaches that the computing device, when the radio communication unit is enabled, provides data communication functionality between the device and an external entity (Col. 5, Lines 53-59; Col. 9, Lines 55-59).

It would therefore have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of **Claxton** and **Tyneski et al.** and **Ditzik** to have modified the invention to include the above teaching of **Ditzik** therefore to have a device that can be quickly configured to notebook wireless and/or PDA embodiments.

Regarding claim 8, it is inherent that the wireless communication device of **Claxton** communicates with a base station that includes an adaptive array because the wireless communication device of **Claxton** is a cellular telephone.

Regarding claim 13, the combination of the teachings of **Claxton** and **Tyneski et al.** also fail to teach that the first mode of operation provides transfer of data between the device and an external entity. However, **Ditzik** in his invention discloses that the first mode of operation provides transfer of data between the device and an external entity (Col. 4, Lines 55-57).

Art Unit: 2682

It would therefore have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of **Claxton** and **Tyneski et al.** and **Ditzik** to have modified the invention to include the above teaching of **Ditzik** therefore to have a device that can be quickly configured to notebook wireless and/or PDA embodiments.

Regarding claim 14, **Ditzik** also teaches that the external entity includes a base station coupled to a data communication network (Col. 3, Lines 16-21).

Regarding claim 15, **Ditzik** also teaches that the external entity further includes a voice communication network (Col. 3, Lines 16-21).

Regarding claim 16, **Ditzik** also teaches that the data communication network includes the Internet (Col. 3, Lines 13-21).

Regarding claim 19, **Claxton** teaches that switching means is coupled to a power supply means (Col. 4, Lines 60-67; Col. 5, Lines 1-2). However, **Claxton** fails to teach that the switching means to disable the supply of power from the power supply means to at least a portion of the second means in the second mode of operation. **Ditzik** on the other hand, discloses that the switching means to disable the supply of power from the power supply means to at least a portion of the second means in the second mode of operation (Col. 6, Lines 50-58; Figs. 1,3).

It would therefore have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of **Claxton** and **Tyneski et al.** and **Ditzik** to have modified the invention to include the above teaching of **Ditzik** to simplify the process of providing power to support the operation modes.

Allowable Subject Matter

6. Claims 20, 21 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Regarding claim 20, **Claxton US Patent 6,434,371** and **Tyneski et al. US Patent 5,584,054** teach the limitations set forth in claim 17; however, both **Claxton US Patent 6,434,371** and **Tyneski et al. US Patent 5,584,054** fail to teach that the apparatus of claim 17, wherein an external entity triggers the selection means to select between the first and second modes of operation.

Regarding claim 21 with respect to claim 20 **Claxton US Patent 6,434,371** and **Tyneski et al. US Patent 5,584,054** did not teach that the apparatus of claim 20, wherein the external entity comprises a transmitter to transmit a signal that

Art Unit: 2682

triggers the selection means to select between the first and second modes of operation.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- a. **Willkie et al. US Patent 5,956,651** discloses Cellular Telephone Interface System for AMPS and CDMA Data.
- b. **Foladare et al. US Patent 5,894,595** discloses Personal Communication System.
- c. **O'Sullivan US Patent 4,972,457** discloses Portable Hybrid Communication System and Methods.
- d. **Tran et al. US Patent 6,038,294** discloses Method and Apparatus for Configuring a Modem Capable of Operating in a Plurality of Modes.

Art Unit: 2682

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MINH D DAO whose telephone number is 703-305-5589. The examiner can normally be reached on 8:30 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, VIVIAN C CHIN can be reached on 703-308-6739. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

Minh Dao

Lee Nguyen 8/22/03
Lee Nguyen
Primary Examiner